

REMARKS:

Claims 31-50 are in the case and presented for consideration. Claims 1-30 have been canceled.

Claims 1-30 have been rejected on the grounds that the invention is directed to non-statutory subject matter, pursuant to 35 U.S.C. §101. It is respectfully submitted that the recent decision, *In re Lundgren*, 76 U.S.P.Q. 1385 (BPAI 2005), traverses this rejection under Section 101.

The Examiner has also rejected claims 1-30 under 35 U.S.C. §112, first paragraph, for not describing the claimed subject matter in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, and under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctively claim the subject matter which applicant regards as the invention.

It is respectfully submitted that the accompanying amendments overcome the Section 112 rejections.

Applicant respectfully requests reconsideration of the subject application in light of the above amendments and the following remarks.

IN RE LUNDGREN TRAVERSES THE § 101 REJECTION

Applicant respectfully submits that decision by the Board of Patent Appeals and Interferences (hereinafter "the Board") in *In re Lundgren*, 76 U.S.P.Q. 1385 (BPAI 2005), traverses the Section 101 rejection.¹

The Office Action (p. 6), in part, states:

"The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, **the claimed invention must be within the technological arts.**" (Emphasis added).

In *Lundgren*, the Board held that the "technological arts" requirement" is no longer a proper test under Section 101 of the Patent Law. *Lundgren* eliminates the Office's policy of rejecting patents under Section 101 as being outside of the "technological arts." Under *Lundgren*, patent protection should no longer be limited to business methods that are implemented via computer or other electronic processing devices.² The Board's decision in *Lundgren* has put Office's practice in line with previous rulings by the United States Court of Appeals for the Federal Circuit, most notably *State Street Bank v. Signature Financial Group*, 149 F.3d 1368, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998); see also *AT&T Corp. v. Excel Communications, Inc.* 50 U.S.P.Q.2d 1447 (Fed. Cir. 1999).

¹ The *Lundgren* decision issued on September 28, 2005, six (6) days after the issuance of the Office Action.

² Applicant does not concede that the claimed invention is outside of the technological arts. However, this issue is mooted by *Lundgren* and does not warrant further discussion.

The Office's Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (hereinafter "Interim Guidelines"), Annex III (p. 42.), has implemented the holding in *Lundgren*.

"USPTO personnel should no longer rely on the technological arts test to determine whether a claimed invention is directed to statutory subject matter. There is no other recognized exceptions to eligible subject matter other than laws of nature, natural phenomena, and abstract ideas."

Further, the method as now claimed also produces a useful, concrete and tangible result, in line with *State Street Bank*, namely, the creation of a complete conceptual design for a product or service, based on the process steps defined.

AMENDMENTS TRAVERSE §112 REJECTIONS

A. Amended Claims Satisfy the Requirements Under §112

Claims 31-50 replace the language that was found objectionable in claims 1-30 with clearer, better-defined language.

For example, Claims 31-50 do not include the language "selecting a team coordinator" (in cancelled claim 1). Thus, the inquiries regarding this language (p.3, Office Action) do not warrant a response. Nevertheless, whether an specific person selects the team coordinator is not important to the claimed invention; it is not a limitation of the claims. Those skilled in the art to which this invention pertains, will understand who the team coordinator is under 35 U.S.C. 112, first and second paragraphs, once the team coordinator has been identified.³

The amended claims also do not include the words "fixed-fluid analysis" (which

³ See, for example, U.S. Patent 4,682,956 to Krane, and U.S. Patent 6,099,319 to Zaltman et al., for examples of method steps to be practiced by humans where a specific individuals need not be identified in association with the practicing of a particular step to be performed.

were recited in cancelled claim1). Thus, the objection to this language is now moot. Instead, the new claim 31 recites the step of "providing a plurality of design parameters related to the product or service, each design parameter being either predetermined or variable, wherein the variable design parameters are subject to development." The specification, at page 11, discloses support for this claim language.

"The fixed-fluid analysis 20 requires the team coordinator to delineate the conceptual design project parameters based on whether a series of elements categorized based on the type of intelligence the element relates to is a fixed, pre-determined element or may be subject to development by the creative process."

Claims 31- 50 do not include the language "conducting an immersion session". Thus, the objection to this language is not at issue. Claim 31 replaces the "conducting immersion session" language with clearer language, namely, "providing the plurality of design parameters and stimuli which relate to the variable design parameters to the team for studying". The specification supports this claim language. The specification states:

"The team members are . . . given immersion stimuli with a description of the project by the team coordinator." (p. 22); and

"The project team is . . . given a project briefing followed by the immersion stimuli." (p. 23).

Claims 31-50

The Examiner concludes that since the claimed method is performed by humans and the claimed method will not create consistent results from use to use, the claims fail to comply with the written description requirement. See Office Action, pp. 2-3. However, that is not the test under 35 U.S.C. §112, first paragraph. The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed includes sufficient information to show that the inventor possessed the

invention at the time of the original filing. *In re Kaslow*, 1375, 217 U.S.P.Q. 1089, 1096 (Fed. Cir. 1983).

Further, the definiteness of the claims must be analyzed, not in a vacuum, but always in light of the teachings of the disclosure as it would be interpreted by one of ordinary skill in the art. Interim Guidelines, page 25. The written description requirement does not require the applicant "to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 54 U.S.P.Q.2d 1227, 1232 (Fed. Cir. 2000). If elements of an invention are well known in the art, the applicant does not have to provide a disclosure that describes those elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81 (Fed. Cir. 1986).

Applicants respectfully submit that one of ordinary skill in the art would be able to use the claimed invention as disclosed in the specification of the subject application. The specification (pp. 20-29) includes three working examples of applicant's method.

The Office has issued patents which claim methods with steps that involve subjective human decisions which very likely produce different results each time the claimed method is conducted. The Examiner's attention is directed to U.S. Patent 6,099,319 to Zaltman, U.S. Patent 4,682,956, and U.S. Patent 5,855,482 to Remer.

B. Office Applies Section 101 Test in Support of Section 112 Rejection

The Section 112 rejections are based on the grounds that applicant's claimed invention does not produce results which are "concrete" or "tangible" or "reproducible" or "meaningful". The Office Action, in part, states:

"All of the steps recited in claims 1-30 are performed entirely by

a human. Furthermore, all of these steps are completely subjective since the scope of each limitation is defined by the particular human carrying out each step. There is no **transformation of the results** of these steps into any **concrete and tangible result**, e.g., via a quantifiable method that repeatedly translates into **real-world, meaningful, and consistent results.**" (Emphasis added).

"Again, such a decision is purely subjective and therefore not **reproducible or concrete or tangible.**" P. 4. (Emphasis added).

"Such an assessment is purely subjective without any transformation into a **concrete and tangible result.**" P. 4. (Emphasis added).

"There is no underlying scientific approach that would yield **reliable, reproducible, and meaningful results** when repeating practice of the invention, especially among a varying set of users. P. 4. (Emphasis added).

"The specification does not adequately disclose the level of details required by one skilled in the relevant art to be enabled to make and/or use the invention with consistency and confidence that the **results are reproducible, tangible, concrete, and meaningful** in a real-world context." P. 5. (Emphasis added).

Thus, it is respectfully submitted that the Section 112 rejections improperly apply the standard for determining the existence of patentable subject matter under Section 101 or a judicial exception.⁴

⁴ The rejections under Section 112, first and second paragraphs, are based on the same grounds. See Office Action, p. 5 ("All of the issues raised in the rejections under 35 U.S.C. § 112, 1st above bring the metes and bounds of the claims into question; therefore, these rejections are applied under 35 U.S.C. §112, 2nd paragraph as well".)

BEST AVAILABLE COPY

The Examiner's attention is respectfully directed to the Interim Guidelines which provide:

"To satisfy section 101 requirements, the claim must be for a practical application of the §101 judicial exception, which can be identified in various ways:

- The claimed invention "transforms" an article or physical object to a different state or thing.
- The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below."

The issue of whether claimed subject matter is statutory or non-statutory is not relevant to determinations under Section 112. In *In re Mahoney*, 164 U.S.P.Q.572 (C.C.P.A. 1970), the Board rejected claims under Section 112 because they read on both "mental and nonmental implementation of a process." In reversing the rejection, the Court of Customs and Patent Appeals held that questions of statutory subject matter should not be injected into the analyses under Section 112.

"That paragraph [Section 112], as quoted above, requires that an applicant distinctly claim what he regards as his invention. To inject any question of statutory subject matter into that paragraph is to depart from its wording and to complicate the law unnecessarily. The proper consideration here is whether the appealed claims cover only what appellant regards as his invention."

Id. at 575.

Thus, it is respectfully submitted that the Section 112 rejections should be withdrawn for the same reason that the Section 101 rejection warrants withdrawal, that is, because the logic and reasoning of this rejection has been traversed by *Lundgren*.

C. Applicant's Claims Are Not *Per Se* Objectionable Simply Because They Implement Steps Carried Out By a Human Mind

The Examiner bases the Section 112 rejections, 1st and 2nd paras., on the grounds that the claimed method implements steps which are carried out by humans. The Office Action, in part, states:

"All of the steps recited in claims 1-30 are performed entirely by a human. Furthermore, all of these steps are completely subjective since the scope of each limitation is defined by the particular human carrying out each step. There is no transformation of the results of these steps into any concrete and tangible result, e.g., via a quantifiable method that repeatedly translates into real-world, meaningful, and consistent results."

However, it is well-settled that process claims are not directed to non-statutory subject matter "merely because some or all of the steps therein can be carried out in or with the aid of the human mind or because it may be necessary for one performing the processes to think." *In re Musgrave*, 167 U.S.P.Q. 280 (C.C.P.A. 1970).

The Interim Guidelines have adopted the court's holding in *In re Musgrave*.

"If a claimed process is performed by a machine, it is immaterial whether some or all the steps could be carried out by the human mind... Therefore, USPTO personnel should no longer rely on the mental step test to determine whether a claimed invention is directed to statutory subject matter.

"It is immaterial whether the process may be performed by some or all steps that are carried out by a human. Claims are not directed to non-statutory processes merely because **some or all** the steps therein can also be carried out in or with the aid of a human or because it may be necessary for one performing the processes to do some or all of the process steps. The inclusion in a patent of a process that may be performed by a person is not fatal to patentability. Alco Standard Corp. v. Tennessee Valley Authority, 808 F.2d 1490, 1496, 1 USPQ2d 1337, 1341 (Fed. Cir. 1987) (citing Diehr, 450 U.S. at 175); see e.g. Smith & Nephew, Inc. v. Ethicon, Inc., 276 F.3d 1304, 61 USPQ2d 1065 (Fed. Cir. 2001) (method claim where all the steps are carried out by a human). Therefore, USPTO personnel should no longer rely on the human step test to determine whether a claimed invention is directed to statutory

subject matter."

Interim Guidelines, pp. 46-47.

Accordingly, the application and claims are believed to be in condition for allowance, and favorable action is respectfully requested. No new matter has been added.

If any issues remain which may be resolved by telephonic communication, the Examiner is respectfully invited to contact the undersigned at the number below, if such will advance the application to allowance.

Favorable action is respectfully requested.

Respectfully submitted,



Peter C. Michalos

Reg. No. 28,643

John Zaccaria

Reg. No. 40,241

Attorneys for Applicants

Tel: 845-359-7700

Dated: February 17, 2006

NOTARO & MICHALOS P.C.
100 Dutch Hill Road, Suite 110
Orangeburg, New York 10962-2100

Customer No. 21706

F:\TEXT\PATAMD\J25-817US-Amd.wpd